

Application No.: 09/872,245
Reply to Office Action dated: November 14, 2007

REMARKS

Claims 8, 18 and 21-24 have been canceled herein, and claims 25-32 have been added. Therefore, claims 2-7, 9-11, 13-17, 19, 20 and 25-32 are pending in the application. In addition, independent claims 5 and 15 have been amended. In view of the foregoing amendments and the following discussion, Applicant respectfully requests reconsideration of the patentability of the claimed subject matter.

35 U.S.C. § 103 Rejections

Governing Legal Principles

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Additionally, to resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper, so that the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. See *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002).

Furthermore, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Discussion of rejections

There Examiner has issued a number of rejections to the claims under 35 U.S.C. § 103(a).

Claims 3, 5 and 9 have been rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,583,543 to Takahashi et al. ('*Takahashi*') in view of U.S. Patent No. 5,710,831 to Beernink ('*Beernink*') and further in view of U.S. Patent No. 6,459,442 to Edwards et al. ('*Edwards*') and U.S. Patent No. 6,452,694 to Eisenberg et al. ('*Eisenberg*'); claims 2, 13, 15, 20 22 and 24 have been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards and Eisenberg* in view of U.S. Patent No. 6,256,009 to Lui et al. ('*Lui*'); claim 4 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards and Eisenberg* in view of U.S. Patent No. 5,546,538 to Cobbley et al. ('*Cobbley*'); claims 6, 8 and 10-11 have been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards and Eisenberg* in view of U.S. Patent No. 5,760,773 to Berman et al. ('*Berman*'); claim 7 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards and Eisenberg* in view of U.S. Patent Application Publication No. 2002/0143831 to Bennett ('*Bennett*'); claim 14 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg and Lui* in further view of *Cobbley*; claims 16 and 18 have been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, Eisenberg and Lui* in view of *Berman*; claim 17 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Eisenberg and Lui* in view of *Bennett*; and claim 19 has been rejected under § 103(a) as being unpatentable over *Takahashi, Beernink, Edwards, and Lui* in view of U.S. Patent No. 5,889,888 to Marianetti et al. ('*Marianetti*').

It is initially noted that independent claims 5 and 15 have been amended to incorporate the features of claims 8 and 18, respectively, (which have been canceled without prejudice) and now recite the feature "implementing a draggable scroll controller within the first touchscreen area for scrolling the portion of the recognized text displayed in the first touchscreen area".

Claims 8 and 18 were rejected based on the *Takahashi, Beernink, Edwards and Eisenberg* references in view of the *Berman* reference.¹ The Examiner relies upon the *Berman* reference as

¹ The incorporation of the features of claims 8 and 18 in independent claims 5 and 15 removes the need to address the other §103(a) rejections.

disclosing a draggable scroll controller and that “it would have been obvious to one of ordinary skill in the art at the time of applicant’s invention to have combined Takahashi’s method of handwriting input with Berman’s method of scrolling text with a draggable scroll controller, since it would have allowed a user to view text that appears before the current word in a method that is traditionally used in software applications.” Office Action, page 10.

Applicant respectfully traverses these assertions. Firstly, *Berman* does not disclose a draggable scroll controller having the features claimed. *Berman* refers to “child windows” which “may take the form of push buttons, radio buttons, check boxes, text entry fields, list boxes, and scroll bars and the like,” and further states that these are among objects which can be “pressed or clicked or scrolled like they have physical existence”. *Berman*, col. 9, lines 31-36. In this section *Berman* merely states that scroll bars exist and can be activated. Nowhere does *Berman* disclose or even suggest that a scroll bar or scroll controller for “scrolling the portion of the recognized text displayed in the first touchscreen area” as claimed.

It is noted that there are several elements which this claimed includes and which *Berman* lacks. Even if, for the sake of argument, it is conceded that Berman discloses a scroll bar with a touchscreen area, there is no disclosure or suggestion that the scroll controller would be in a first (1) touchscreen area, or that the scrolling is for a portion (2) of recognized text (3) displayed in the first touchscreen area. The Examiner cannot simply take the extremely bare disclosure of the scroll bar in *Berman* and then assume a scroll bar that implements the elements highlighted above (i.e., in the first touchscreen and for a portion of recognized text) based on a purported combination with the features of *Takahashi*, *Beernink*, *Edwards* and *Eisenberg* reference – none of which refers to a draggable scroll controller at all.

It is therefore submitted that the combination of *Takahashi*, *Beernink*, *Edwards*, *Eisenberg* and *Berman* does not disclose or suggest all of the elements of amended independent claims 5 and 15. Therefore independent claim 5 and its dependent 2-4, 6, 7 and 9-11, and independent claim 15 and its dependent claims 12-14, 16, 17, 19 and 20 are patentable over the references relied upon.

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New Claims

New independent claims 25 and 29 recite a system and method of editing text using first and second areas of a touch panel display that is not disclosed or suggested by the references relied upon, whether taken alone or combined. It is therefore submitted that independent claims 25 and 29 and their respective dependent claims 26-28 and 30-32 are patentable.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections, and that they be withdrawn. The Examiner is invited to telephone the undersigned representative if an interview might expedite allowance of this application.

Respectfully submitted,

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